

Remarks:Introduction

These remarks are responsive to the Office action dated November 10, 2004. Prior to entry of this amendment, claims 1-29 remained pending in the application. By this amendment, applicant has amended claims 1, 12, and 22.

In the November 10, 2004 Office action, claims 1, 5-10, 12, 15-20, 22, and 25-29 were rejected under 35 U.S.C. 102(b) as being anticipated by Linsker et al. (U.S. Pat. No. 5,680,455), and claims 2-4, 11, 13, 14, 21, 23, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Linsker et al. in view of Davis et al. (U.S. Pat. No. 5,633,932). Furthermore, the disclosure was objected to based on an informality.

Applicant respectfully disagrees with the Examiner's rejections under 35 U.S.C. § 102 and under 35 U.S.C. § 103. Nevertheless, in the interest of furthering prosecution, applicant has amended the independent claims to more clearly distinguish the prior art. Such amendments are made without prejudice to further prosecution in this application or any related application.

Objection under 35 U.S.C. § 112

Applicant has amended the specification to address an informality in the paragraph beginning at page 2, line 9. The amendment does not introduce new matter and resolves the informality. Furthermore, applicant has amended the abstract to reflect changes made to the claims.

Rejections under 35 U.S.C. § 102

Claims 1, 5-10, 12, 15-20, 22, and 25-29 were rejected under § 102 as being anticipated by Linsker et al. A single prior art reference must disclose each and every element of a claim to anticipate that claim under § 102. Accordingly, in order for

Page 9 - AMENDMENT
Serial No. 09/905,415
HP Docket No. 10010635-1
KH Docket No. HPCB 326

Linsker et al. to properly anticipate claims 1, 5-10, 12, 15-20, 22, and 25-29, it must disclose, for each claim, each and every recited element.

As amended, independent claims 1, 12, and 22 recite restricting printing to only those users that have been verified and which have permission to print. In accordance with this concept, each of claims 1, 12, and 22 has been amended to include a determination of whether a user has permission to print. Support for these amendments can be found at least in the second paragraph of page 6 of applicant's disclosure.

Unlike amended claims 1, 12, and 22, Linsker et al. do not disclose regulating the ability of a user to print on a printer by limiting printing to only those instances when the user is a verified user and has permission to print. In fact, Linsker et al. are utterly silent regarding printing permissions. Instead, Linsker et al. merely describe a method of authenticating and providing non-reputability of analog messages sent via facsimile machines. Unlike the inventions recited in claims 1, 12, and 22, Linsker et al. do not teach any gate keeping methodology which ensures that only users with permission (e.g. users that have been pre-approved, and/or users that have not been prohibited), will be allowed to execute a printing job. As explained in the application, this can be important because of the costs associated with print jobs, particularly large print jobs and/or color print jobs. Accordingly, providing a mechanism for reliably preventing unwanted print jobs, and for accurately identifying the source of print jobs, is desirable. Linsker et al. do not teach such a methodology, presumably because unwanted jobs are not a serious problem in the context of facsimile machines.

Page 10 - AMENDMENT
Serial No. 09/905,415
HP Docket No. 10010635-1
KH Docket No. HPCB 326

Because Linsker et al. do not teach determining if a user with a private key has permission to print, or printing a document on a printer only if a user is a verified user and has permission to print, Linsker et al. cannot anticipate independent claims 1, 12, and 22. Accordingly, rejection of those claims should be withdrawn for at least the above described reasons. Furthermore, claims 2-11, 13-21, and 23-29 depend from independent claims 1, 12, and 22, respectively, and rejection of those dependent claims should be withdrawn for at least the same reasons as for the independent claims.

Rejections under 35 U.S.C. § 103

Claims 2-4, 11, 13, 14, 21, 23, and 24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Linsker et al. in view of Davis et al. Each of these claims depends from an independent claim that is believed to be in condition for allowance. Accordingly, as explained above, rejection of these dependent claims should also be withdrawn. Furthermore, Linsker et al. and Davis et al. cannot render any of the pending claims obvious under § 103 because the references do not contain an explicit motivation or suggestion to combine, and even if such a motivation or suggestion did exist, the resulting piecemeal combination would render the references unsatisfactory for their intended purposes, as well as change the principle of operation of the references. Accordingly, prima facie obviousness does not exist for any of the pending claims.

Conclusion

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending

Page 11 - AMENDMENT
Serial No. 09/905,415
HP Docket No. 10010635-1
KH Docket No. HPCB 326

02/01/05

15:51

☎5039729115

KOLISCH HARTWELL

015/015

claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.



Walter W. Karnstein
Registration No. 35,565
Customer No. 23581
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicant

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner B. Hoffman, Group Art Unit 2136, Assistant Commissioner for Patents, at facsimile number (703) 872-9306 on February 1, 2005.


Christie A. Doolittle

Page 12 -

AMENDMENT
Serial No. 09/905,415
HP Docket No. 10010635-1
KH Docket No. HPCB 326